



KIMBERLY D. BALLEW
Associate Patent Counsel
Legal Department

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michelle CARRIER
Gerald MEETEN

Serial No.: 10/517,332

International Application No. PCT/GB04/02863

International Filing Date: July 2, 2004

For: ELECTRICAL TREATMENT FOR OIL BASED
DRILLING OR COMPLETION FLUIDS

Priority Date: August 12, 2003

Confirmation No.: 4243

Examiner: Darrell C. Cottman

Atty. Dkt. No.: PA-00422US1

**PETITION UNDER 37 C.F.R. § 1.47(a) FOR ACCEPTANCE OF APPLICATION
WHERE JOINT INVENTOR CANNOT BE LOCATED
TO JOIN IN APPLICATION FOR PATENT**

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

CERTIFICATE OF MAILING BY EXPRESS MAIL (37 CFR 1.10)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10 with sufficient postage in an envelope addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Express Mail Number: EV793164755US

Date of Mailing: April 12, 2006

Paul Bardin

Sir:

The above-captioned patent application was filed with the United States Patent Office on December 9, 2004, under 35 U.S.C. 371 and has been assigned application Serial No. 10/517,332. A Preliminary Amendment was submitted with the application filed on December 9, 2004. No Office Actions on the merits have been received. Applicant's attorney received a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" that was mailed on June 7, 2005, because an inventor's

declaration was not submitted with the application. The assignee of this patent application, M-I L.L.C., has not been able to obtain the required declaration because one of the joint inventors, Dr. Michelle Bridget Carrier, cannot be located to sign it. The signed declaration of the other joint inventor is attached.

This statement recites facts that establish the propriety of this petition, and that set out the nonsigning joint inventor's last known address:

- (1) The joint inventor of the above-captioned application, Dr. Carrier, was an employee of Schlumberger Cambridge Research Limited at the time the invention was conceived. Dr. Carrier was involved with and cooperated in the preparation of the parent to this application. That parent application is PCT/GB04/02863 filed on July 2, 2004, which claims priority to GB0318840.6 filed on August 12, 2003.
- (2) After filing of the parent application, Dr. Carrier left the employment of Schlumberger Cambridge Research Limited (hereinafter "SCRL").
- (3) M-I L.L.C. and SCRL are parties to a Research Agreement, the result of which provides for the assignment of this application to M-I L.L.C. *See* Research Agreement Between M-I L.L.C. and Schlumberger Cambridge Research Limited (hereinafter, the "Research Agreement"), labeled Exhibit A. A redacted copy of the Research Agreement is provided. In the event that the Office of Petitions requires a non-redacted copy, such copy will be provided by petitioner in

accordance with the method described under 724.02 of the Manual of Patent Examining Procedure.

- (4) On February 18, 2005, Ms. Leah Bardin, a paralegal at M-I L.L.C., which now owns the above-captioned application, sent an email to Ms. Anna Bruce, a paralegal at SCRL, requesting the last known address for Dr. Carrier.
- (5) On February 22, 2005, Ms. Bardin received the last known address for Dr. Carrier from Ms. Bruce via electronic mail as: 3 Ainsworth Court, Cambridge CB1 2PA, United Kingdom.
- (6) On August 8, 2005, Ms. Leah Bardin, a patent paralegal for M-I L.L.C. sent a letter and a copy of the application and Preliminary Amendment along with the declaration to Dr. Carrier via DHL to obtain her necessary signature on the declaration. *See* August 8 Letter to Dr. Carrier labeled Exhibit B.
- (7) On September 28, 2005, Ms. Bardin received an electronic mail communication from Dr. Carrier providing a new address as: Flat 1, 55 Rattray Road, London SW2 1BB, United Kingdom (the "New Address"). *See* September 28 E-Mail labeled Exhibit C.
- (8) Ms. Bardin sent another letter, copy of the application, copy of the Preliminary Amendment and declaration to Dr. Carrier via DHL to the New Address on October 14, 2005 asking her to sign and return the declaration. *See* October 14 Letter to Dr. Carrier labeled Exhibit D.

- (9) In the October 14 Letter, a copy of an additional application and declaration were also included. That application, related to the subject application was the subject of a separate petition under 37 U.S.C. §1.47, filed August 22, 2005, that was pending at the time the October 14 Letter was sent. That petition was subsequently granted.
- (10) Not having heard back from Dr. Carrier by March 12, 2006, Ms. Bardin sent yet another letter, copy of the application, copy of the Preliminary Amendment and declaration to Dr. Carrier via DHL to the New Address asking her to sign and return the declaration. *See* March 12 Letter to Dr. Carrier labeled Exhibit E.
- (11) In each letter, a telephone number and e-mail address were provided in the event that Dr. Carrier had any questions regarding the matter. Further, a DHL envelope and airbill were provided for Dr. Carrier's use in returning the declaration to M-I L.L.C. To date, no response has been received from Dr. Carrier and none of the letters sent to Dr. Carrier's last known address via DHL have been returned by DHL as undeliverable.

The end result of M-I L.L.C.'s attempts to contact Dr. Carrier, a joint inventor, was that Dr. Carrier could not be positively located to sign the declaration. Applicant thus respectfully requests acceptance of the application under 37 C.F.R. § 1.47(a).

Please deduct the fee required under 37 C.F.R. § 1.17(g) from M-I L.L.C.'s Deposit Account No. 13-3082, Order No. PA-00422US1. Should any additional fee deemed necessary

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Atty. Ref.: PA-00422US1

for any reason relating to this document, the Commissioner is hereby authorized to deduct said fee from, or credit any overpayment to, M-I L.L.C. Deposit Account No. 13-3082, Order No. PA-00422US1. In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,



Kimberly D. Ballew
Patent Attorney
Reg. No. 52,822

Tel. 281 561 1454
Fax. 281 561 1452
Email: kballew@miswaco.com

Date: April 12, 2006

04/18/2006 MKAYPAGH 00000141 133082 10517332

01 FC:1464 130.00 DA

RESEARCH AGREEMENT

Between

MI LLC

and

SCHLUMBERGER CAMBRIDGE RESEARCH LIMITED

THIS AGREEMENT is made effective as of the first day of January 2000.

Between:

- (1) MI LLC, having an office at 5950 North Course Drive (77072), P.O. Box 721110,
Houston, Texas 77272 U.S.A.

on behalf of itself and its Affiliates ("MI")

and

- (2) Schlumberger Cambridge Research Limited, of High Cross, Madingley Road,
Cambridge CB3 0EL England, on behalf of itself and its Affiliates ("SCR").

WHEREAS:

MI is a leading supplier of drilling fluids related compositions, equipment and services;

SCR is a Research Laboratory of the Schlumberger Oilfield Services Group, comprised of SCR Affiliates, having scientific expertise in broad areas of oilfield services related technologies including, as a part thereof, expertise in drilling fluid chemistry and processes;

MI has acquired and merged the drilling fluid related business and engineering groups of Schlumberger Oilfield Service Group, and desires to take the place of those groups as sponsor and beneficiary of SCR's research work; and

SCR desires to continue research work in the field of drilling fluid chemistry and processes on behalf of MI

MI desires that SCR continue its research work in the field of drilling fluid chemistry and processes on behalf of MI and SCR desires to continue such a research work.

IT IS HEREBY AGREED THAT:

1 DEFINITIONS

In this Agreement:

- 1.1 "Confidential Information" shall mean any information disclosed by one party to the other and/or its affiliates, including any software in either source or object code, computer program, algorithms, technical, proprietary, engineering, operational information, specimen, processes, apparatus, equipment, formulae, proprietary knowledge, know-how, data and specifications whether patented or not, but excluding information that:
- (a) is in the public domain at the time of disclosure; or
 - (b) enters the public domain after disclosure to a Party, and not as the result of breach by such Party under this Agreement; or

- (c) is in the possession of a recipient Party prior to disclosure to it, and was not then subject to an obligation of confidence to the disclosing Party; or
- (d) is disclosed to a Party by a third person without any breach of an obligation of confidence; or
- (e) is independently created by the recipient Party as a result of work carried out by an employee to whom no disclosure of the relevant Confidential Information has been made.

Any information which is specific and has been disclosed in confidence shall not be deemed to come within any of the foregoing exceptions merely because such specific information is embraced by general disclosures in the public domain; nor shall a combination of two or more features included within such Confidential Information be deemed to be within any of such foregoing exceptions merely because one or more of such features individually come within any of such exceptions.

- 1.2 "Intellectual Property" means patents, registered and unregistered designs, registered and unregistered trade marks, design rights, topography and mask rights, copyrights (including the copyright on software in any code), know-how and trade secrets, rights in inventions, discoveries, improvements as well as applications for any such rights and any rights of a similar or equivalent nature which arise in any jurisdiction.
- 1.3 "Background Intellectual Property" means any Intellectual Property owned by or at the free disposal of the parties and not generated in the performance of the Research Project.
- 1.4 "Results" means all results and information generated by SCR pursuant to and during the term of this Agreement.
- 1.5 "Research Projects" means scientific projects undertaken by SCR and either relating directly to drilling fluid technology or having a beneficial impact on Drilling Fluid Technology.
- 1.6 "Drilling Fluid Technology" means compositions, additives, formulations, processes and impact of fluids circulated through the drillstring and the annulus of the wellbore during drilling.
- 1.7 "Affiliate" means any business entity that is owned or controlled by a Party, that owns or controls a Party, or that is owned or controlled by a business entity owning or controlling a Party. Direct or indirect ownership of more than fifty percent of the voting stock ordinarily entitled to vote in the election of directors of a business entity or, if no such stock is issued, of more than fifty percent of the ownership interest in the business entity, shall constitute ownership thereof.

2 RESEARCH PROJECTS

2.1

2.2

2.3

3 REPORTING

3.1

3.2

3.3

4 FUNDING

4.1

5 OWNERSHIP AND EXPLOITATION OF INTELLECTUAL PROPERTY

5.1 For the avoidance of doubt all Background Intellectual Property used in connection with the Research Projects shall remain the property of the party introducing the same.

5.2 Due to the nature of the research work performed by SCR which encompasses drilling fluids technology and other oilfield services technologies as well as integrated approaches combining drilling fluids components with other components, it is the understanding of the parties that the Results of the Research Project may not be easily identifiable as purely drilling fluid technology, and may not be readily assignable to one of the parties or its affiliated companies. The parties therefore

RL

agree that, in the first instance and prior to any other agreement between the parties, all Results and all rights therein shall be owned by SCR and its affiliated companies.

- 5.3 In case certain Results are solely applicable to Drilling Fluid Technology, MI shall have the right to request a transfer of ownership of such Results and all rights thereof from SCR or its affiliated companies, as the case may be, to MI. Upon such request, SCR or its affiliated companies shall transfer and assign the ownership to MI without undue delay, at the cost of MI. This transfer shall be irrevocable, royalty-free, worldwide and perpetual, and SCR and its Affiliates shall retain a non-exclusive, royalty-free, worldwide and perpetual license to use such Results in their normal course of business, without the right to transfer said rights to a third party.

5.4

5.5

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- 5.7 The costs of obtaining intellectual property registration, such as patents, shall be borne by MI for Drilling Fluids Technology under section 5.3;

5.8

5.9

6 TERMINATION

6.1.

6.2.

6.3.


7 INDEPENDENT CONTRACTOR

7.1

8 DISCLAIMER AND INDEMNITY

8.1

8.2

A handwritten signature in black ink, located in the bottom right corner of the page. The signature is stylized and appears to be a combination of initials and a surname.

8.3

8.4

8.5

9 ASSIGNMENT

9.1

10 FORCE MAJEURE

10.1

11 WHOLE AGREEMENT, INTEGRATION, AND LAW

11.1

11.2

11.3

11.4

PL 1/16

12 SURVIVAL OF RIGHTS ON EXPIRY OR TERMINATION

- 12.1 The following sections of this Agreement are expressly intended by the parties to survive the expiry or termination of this Agreement: section 3.3, article 5 and article 8.

ML
SIGNED on behalf of MI

Monica Norman

Monica Norman
Vice President, Technology

SIGNED on behalf of SCR *PH*

Mike Sheppard

Mike Sheppard
Schlumberger Fellow & Managing Director

PH ML

MISWACO

REC'D PCT/PTO 12 APR 2004

M-I LLC

5950 North Course · Houston, Texas 77072

Tel: 281-561-1300 · Fax: 281-561-1452 · www.miswaco.com

Writer's Direct Dial:

281-561-1451

Lbardin@miswaco.com

Via DHL

August 8, 2005

Dr. Michelle B. Carrier
3 Ainsworth Court
Cambridge CB1 2PA
United Kingdom

Re: *U.S. Patent Application Serial Number: 10/517,332 Corresponding to PCT International
Application Number: PCT/GB04/02863 Filed July 2, 2004 July 2, 2004*
Entitled: Electrical Treatment for Oil-Based Drilling or Completion Fluids
Our Ref: PA-00422US1

Dear Dr. Carrier:

We write you regarding a patent application in which you are listed as an inventor along with Gerald Henry Meeten, that was filed when you were employed with Schlumberger (a copy of your employment agreement is enclosed). The parent application was filed in Great Britain on August 12, 2003 and a year later the PCT application was filed on July 2, 2004. We have now entered the U.S. national stage of the PCT application. Enclosed please find a copy of the patent application as filed along with an Inventors Declaration and a copy of the Preliminary Amendment filed as well. [Would you] please review these documents and sign and date the enclosed Declaration? The documents should be returned to us in the enclosed DHL envelope at your earliest convenience.

Should you have any questions regarding this matter, please do not hesitate to contact me or Kimberly D. Ballew at 713-561-1454 or at kballew@miswaco.com. Thank you for your assistance with this matter.

Kind regards,



Leah S. Bardin
Patent Paralegal

Encl.

cc: Carter J. White, Ph.D.
Kimberly D. Ballew, Esq.
Akram Mirza [Schlumberger]

Exhibit B

As to item (2), petitioner states
that applicant could not
be located. However,
it appears by the evidence
presented that the non-
applicant has been located
but may be refusing to
execute the application.
In any event,

Bardin, Leah

From: Michelle Carrier [michellecarrier2003@yahoo.co.uk]
Sent: Wednesday, September 28, 2005 3:53 PM
To: Bardin, Leah
Subject: Patent

Dear Ms Bardin

I have recieved from y;ou a copy of the patent application for PCT application number, PCT/GB04/02863 filed July 2, 2004.based

Electrical Treatment for Oil-Based Drilling or Completion Fluids.

This was sent to the wrong address and hence has an incorrect address on the inventors declaration. Please amend the document with the following address and resend it to me at:

Dr. Michelle Carrier
Flat 1
55 Rattray Road
London
SW2 1BB

I also require a new DHL envelope to return it to you.

Yours Sincerely,

Michelle Carrier

To help you stay safe and secure online, we've developed the all new Yahoo! Security Centre. <http://uk.security.yahoo.com>

Exhibit C

Writer's Direct Dial:
281-561-1451
Lbardin@miswaco.com

Via DHL

March 12, 2006

Dr. Michelle B. Carrier
Flat 1, 55 Rattray Road
London SW2 1BB
United Kingdom


Re: *U.S. Patent Application Serial Number: 10/517,332 Corresponding to PCT International
Application Number: PCT/GB04/02863 Filed: July 2, 2004
Priority Date: August 12, 2003
Entitled: Electrical Treatment for Oil-Based Drilling or Completion Fluids
Our Ref: PA-00422US1*

Dear Dr. Carrier:

Further to my letter of October 14, 2005, please find the enclosed inventor Declaration for your execution as well as the International application and Preliminary Amendment which was filed in the above-referenced U.S. national phase of PCT application no. PCT/GB04/02863, on December 9, 2004. Please sign and date in the appropriate place and return to me at your earliest convenience. I have also enclosed a DHL envelope and airbill for your use in returning the document to us.

Should you have any questions regarding this matter, please do not hesitate to contact me or Kimberly D. Ballew at 713-561-1450 or at kballew@miswaco.com. Thank you for your assistance with this matter.

Kind regards,


Leah S. Bardin
Patent Paralegal

Encl.

cc: Carter J. White, Ph.D.
Kimberly D. Ballew, Esq.

Exhibit E

Writer's Direct Dial:
281-561-1451
Lbardin@miswaco.com

Via DHL

October 14, 2005

Dr. Michelle B. Carrier
Flat 1, 55 Rattray Road
London SW2 1BB
United Kingdom

Re: *U.S. Patent Application Serial Number: 10/517,332 Corresponding to PCT International Application Number: PCT/GB04/02863 Filed: July 2, 2004*
Entitled: Electrical Treatment for Oil-Based Drilling or Completion Fluids
Our Ref: PA-00422US1

U.S. Patent application Serial Number 11/008,009 Filed: December 9, 2004,
Continuation of PCT/GB04/02863 filed July 2, 2004
Entitled: Electrical Treatment for Oil-Based Drilling or Completion Fluids
Our Ref: PA-00422US2

Dear Dr. Carrier:

Thank you for your email of September 28, 2005. Please find the enclosed inventor Declarations for your execution as well as the International application as filed which was filed in the above-referenced applications, and two preliminary amendments that were filed in each application also. Please sign and date both declarations and return them to me at your earliest convenience. I have also enclosed a DHL envelope and airbill for your use in returning the documents to us.

Should you have any questions regarding this matter, please do not hesitate to contact me or Kimberly D. Ballew at 713-561-1450 or at kballew@miswaco.com. Thank you for your assistance with this matter.

Kind regards,

Leah S. Bardin
Patent Paralegal

Encl.

cc: Carter J. White, Ph.D.
Kimberly D. Ballew, Esq.

Exhibit D